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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,825	11/30/2001	Michael B. Sundel	002250-2	2660
22204	7590	11/02/2006	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3692	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/996,825	SUNDEL, MICHAEL B.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Narayanswamy Subramanian	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, 23-31, 33, 34 and 36-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-11, 23-31, 33, 34 and 36-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This office action is in response to applicants' communication filed on August 2, 2006. Amendments to claims 1 and 33 and cancellation of claims 3, 32, 35 and 52 have been entered. Rejections of claims 35 and 52 under 35 USC § 112, second paragraph are withdrawn in view of the amendments. Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are currently pending and have been examined. The rejections and response to arguments are stated below.

#### *Specification*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 include the limitation "electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs". However, the specification does not provide a written description disclosure to support the claimed limitation of "electronically storing package data,

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for the package, and including item data, for the items in the package, in a database, before shipment occurs".

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

For the art rejections given below, the claims are interpreted in light of 35 U.S.C. § 112, first paragraph rejections discussed above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 33 recite the limitation "tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient

to the Sender". There is no antecedent basis for this limitation because the shipment or return of the package has not been positively recited before this limitation. Appropriate clarification/correction is required. Claims 2, 4-11, 23-31, 34 and 36-51 are rejected by way of dependency on a rejected independent claim.

Claims 1 and 33 also recite the limitation "of the one more items of the items of the package". It is not clear what the applicant means by the term "of the one more items". These claims also recite the limitation "permitting an authorized user to query the database" and "rendering data for display to an authorized user". It is not clear if these two authorized users are the same user or different users. Appropriate clarification/correction is required. Claims 2, 4-11, 23-31, 34 and 36-51 are rejected by way of dependency on a rejected independent claim.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 33, 34 and 36-51 are rejected because the claimed invention is directed to non-statutory subject matter.

Claims 33, 34 and 36-51 of the disclosed invention are inoperative and therefore lack utility.

Claims 33, 34 and 36-51 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Figure 6 of the

applicant's drawings only shows some hardware elements of the system. It is not clear how these elements are related to the claimed invention. Applicant has not shown how these hardware elements map on to the limitations of the claimed invention.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 are rejected under 35 U.S.C. 103(a) as being unpatentable Williams et al (US Pub. No. 2002/0032612 A1) in view of Le et al (US Pub. No. 2003/0069831 A1).

Claims 1 and 33, Williams teaches a computer-implemented method and system for processing shipment and return of a package containing items from a Sender to a Recipient (See Williams Abstract), the method comprising the steps of: electronically storing package data, for the package, and including item data, for the items in the package, in a database (See Williams

Paragraphs 148-150, 375, Figures 27A and 40); electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism (See Williams Paragraphs 148-152, 375); electronically adding the shipment tracking data to the database (See Williams Paragraphs 148-152); electronically correlating the package data in the database with the shipment tracking data (See Williams Paragraphs 149, 455-472); and permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-410) and rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one more items of the items of the package (See Williams Paragraphs 28, 30, 133, 136, 152 and 375-410).

Williams does not explicitly teach the step of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker.

Le teaches the step of electronically determining whether the package requires customs clearance (See Le Paragraphs 15-18 and 38-41) and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker (See Le Paragraphs 51-54) and also the step of rendering data for display to an authorized user, based on a query of the database for shipping parameters of the package (See Le Paragraphs 52-54).

Both Williams and Le are concerned with providing transport logistics support for users in trading goods. It would have been obvious to one with ordinary skill in the art at the time of the current invention to combine the steps taught by Riggs to the invention of Williams. The combination of the disclosures taken as a whole, suggests that users would have benefited from the convenience of complying with customs regulations in one session using a user-friendly interface.

Claims 2 and 34, Williams teaches the step of electronically assigning the package to a specific combination of a shipper and shipping method based on the package data (See Williams Figures 12 and 38, Paragraphs 330-371).

Claims 4-11 and 36-43, Williams teaches the steps wherein the package data includes at least the originating address and the destination address (See Williams Figure 27A), and the item data includes a description of the items in the package (See Williams Paragraph 150), said method further comprising the step of: using the package data to electronically calculate shipping charges and electronically generate invoices associated with the shipment (See Williams Paragraph 333); wherein the item data includes the description and value of each item (See Williams Paragraph 150); wherein the step of storing package data comprises transmitting package data via the Internet (See Williams Paragraphs 138, 139 and 142); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network including the Internet in response to the query parameters (See Williams Paragraphs 138, 139 and 142); further comprising the steps of: electronically adding returned item information to the database if items from the package are returned to the Sender (See Williams Paragraph 150); in the case of international shipments,



electronically preparing duty and tax refund claims based on the returned item information and the corresponding item data; and electronically adding duty and tax refund information to the database (See Williams Paragraphs 187, 199, 204, 253 and 254, additional components of refund are interpreted to include duty also); wherein said permitting step comprises receiving a query over a computer network and transmitting data from the database over the computer network in response to the query parameters (See Williams Paragraphs 152 and 153); wherein the computer network comprises the Internet (See Williams Paragraphs 142, 152 and 153).

Claims 23-26, 28-30, 44-47 and 49-52, Williams teaches the steps and means of selecting a shipping assignment for the package based on the package data (See Williams Paragraphs 330-371); generating appropriate shipping documents for the package (See Williams Abstract and Paragraph 17) comprising package labels (See Williams Paragraph 258) and shipping manifests (See Williams Paragraphs 396 and 404); providing a Web site page for permitting the authorized user to query the database (See Williams Paragraphs 173, 174, 179-182); generating duty and tax refund claims based upon Receipt of returned item data (See Williams Paragraphs 497 and 533); adding return item information to said database if items from a package are returned to the Sender (See Williams Paragraph 639), and preparing duty and tax refund claims based on the returned item information (See Williams Paragraphs 497 and 533).

Claims 27 and 48 Le teaches the step wherein shipping documents comprises customs forms (See Le Paragraphs 50-52)

Claims 31, 32 and 52, Williams teaches computer program product including one or more computer-readable instructions configured to cause one or more computer processors to perform the steps recited in claim 1 and a computer system including one or more hardware and/or

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software devices configured to perform the steps recited in method of claim 1 (See discussion of claims 1 and 33 above). A computer program product and a computer system including one or more hardware and/or software devices are inherent in the disclosure of Williams.

***Response to Arguments***

12. Applicant's arguments with respect to pending claims 1, 2, 4-11, 23-31, 33, 34 and 36-51 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Le et al (US Pub. No. 2003/0065949 A1) (April 3, 2003) International Trade System.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian  
Primary Examiner

October 21, 2006